

## REMARKS/ARGUMENTS

Claims 1 through 31 are pending in this application. Claims 1, 9, and 17 have been amended. Support for the amendment may be found throughout the specification and in particular, page 7, [0017]. No new matter has been added.

### Claim Rejections- 35 U.S.C. § 102

The Patent Office rejected Claims 1 through 31 under 35 U.S.C. § 102(b) as being anticipated by Atech Flash and their product “PRO II USB MULTI-SLOT CARD READER/WRITER” (hereinafter referred to as PRO II). Applicants respectfully traverse.

The present invention relates to a USB flash bay which may be integrated with an information handling system assembly. The USB flash bay is suitable for being inserted in an external drive bay of an information handling system assembly. The USB flash bay includes at least one USB port, at least one flash card slot, at least one USB hub, and at least one flash card reader controller. The at least one flash card reader controller is capable of interfacing with a USB hub and enumerates as a standard USB mass storage device and thus, does not require a driver to read supported media.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). If anticipation is based upon the inherent teaching of a prior art reference, the Examiner must provide a rationale or evidence tending to show inherency. As stated in *In re Robertson*, “to establish inherency the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be recognized by persons of ordinary skill.” (emphasis added) *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Additionally, “inherency, however, may not be established by probabilities or possibilities.” *Id.* Moreover, “the

mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.*

The Patent Office, while rejecting Claims 1 through 31, has particularly reviewed Claim 1. Claim 1, along with Claims 9, 17, and 25, include elements that have not been taught, disclosed or suggested by PRO II. For example, PRO II fails to teach, disclose or suggest “the flash card reader controller interfacing with the USB hub and the flash card reader being operable as a USB mass storage device” as recited in Claim 1. First, PRO II does not explicitly disclose a flash card reader controller interfacing with the USB hub and enumerating as a USB mass storage device for no mention or suggestion of such limitation is present within the PRO II reference.

Applicants further assert that “the flash card reader controller interfacing with the USB hub and the flash card reader being operable as a USB mass storage device” element is not inherently present in PRO II. For example, many flash card readers require a driver to read supported media. The flash card reader disclosed in PRO II falls within this group as indicated by the disclosure “... load the software drivers first and then plug in the card reader and after the usual “detecting new hardware” routine it is ready to be used.” PRO II, Page 2, Paragraph 2. In contrast, the present invention does not require a driver to read any of the supported media. As recited in Claim 1, the flash card reader controller interfaces with the USB hub and the flash card reader being operable as a USB mass storage device. Such feature eliminates the need for a driver in order to read the supported media. Thus, not only does PRO II fail to teach, disclose, or suggest a flash card reader controller interfacing with the USB hub and the flash card reader being operable as a USB mass storage device such reference teaches away from the present invention as claimed.

Accordingly, the rejection of Claim 1 should be withdrawn, and Claim 1 is allowed for PRO II fails to explicitly or implicitly teach, disclose, or suggest a flash card reader controller interfacing with the USB hub and the flash card reader being operable as a USB mass storage device. Claims 9, 17, and 25 are believed to be allowable for similar

reasoning. Claims 2-8, 10-16, 18-24, and 26-31 are believed to be allowable based on their dependence upon allowable base claims.

*Claim Rejections – 35 U.S.C. § 103*

The Patent Office rejected Claims 4, 12, 20, and 29 under 35 U.S.C. § 103(a) for being unpatentable over PRO II in view of Intel (Communication and Networking Riser Specification Revision 1.2; hereinafter referred to as Intel). Claims 5, 13, and 21 stand rejected under 35 U.S.C. § 103(a) for being unpatentable over PRO II in view of ordinary skill in the art. Claims 6, 14, and 22 stand rejected under 35 U.S.C. § 103(a) for being unpatentable over PRO II in view of Li (United States Patent No. 6,681,991B1; hereinafter referred to as Li). Applicants respectfully traverse.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). In addition, “a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” M.P.E.P. 2131.02, citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

As indicated in the foregoing *Claim Rejections – 35 U.S.C. § 102* section, the primary reference, PRO II fails to disclose, teach or suggest all the elements recited in Claims 1,

9, and 17. Applicants respectfully submit that any of the ancillary references (Intel or Li) or ordinary skill in the art does not make up for the defects of PRO II.

Intel is cited for the disclosure of connecting the information handling system to the flash card reader through a connection other than a USB cable which the Patent office admitted that PRO II does not explicitly disclose. Further, Li is cited for the disclosure of a flash card reader including five flash card slots, which the Patent office admitted that PRO II does not explicitly disclose. However, neither Intel or Li cure the defect of PRO II in reference to Claims 1, 9, and 17 for they do not explicitly or implicitly teach or suggest “a flash card reader controller interfacing with the USB hub and the flash card reader being operable as a USB mass storage device” as recited in Claim 1.

In regards to Claim 5, 13, and 21 as the Examiner is well aware, Applicants are required to seasonably challenge statements by the Examiner that are not supported on the record, and failure to do so will be construed as an admission by the Applicants that the statement is true. M.P.E.P. §2144.03. Therefore, in accordance with such duty to seasonably challenge such unsupported statements, the Examiner is hereby requested to cite a reference supporting the position that “it would have been obvious to one of ordinary skill in the art to include at least four USB ports on the faceplate such that the functionality of the information handling system is improved while at the same time providing enhanced connectivity to peripheral devices.” Office Action, Page 8, Paragraph 1. If the Examiner is unable to provide such a reference, and is relying on facts based on personal knowledge, Applicants hereby request that such facts be set forth in an affidavit from the Examiner under 37 C.F.R. 1.104(d)(2). Absent substantiation by the Examiner, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

Thus, independent Claims 1, 9, 17, and 25 are nonobvious under 35 U.S.C. § 103(a). Claims 4-6, 12-14, 20-22, and 29 are believed to be allowable based on their dependence upon allowable base claims. Removal of all the pending rejections under 35 U.S.C. §103 is respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, Applicants respectfully request a timely Notice of Allowance.

Respectfully submitted,

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